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09/822,839	04/02/2001	Masao Tsuruta	Q60559	8477
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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037-3213				DEXTER, CLARK F
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/822,839
Filing Date: April 02, 2001
Appellant(s): TSURUTA, MASAO

MAILED
JUL 13 2005
Group 3700

Daniel V. Williams
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 25, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. In short, an after-final response was filed but no amendments to the claims were made in the response.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2 and 4 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,595,370	Fujishiro	7-1971
5,743,374	Monsees	4-1998
1-210298	Japan	8-1989

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monsees, pn 5,743,374, in view of Fujishiro et al., pn 3,595,370.

Monsees discloses an apparatus with almost every structural limitation of the claimed invention as follows:

means (e.g., O) for supplying stacked sheets;

means (e.g., 10) for vertically inverting the stacked sheets;

means (e.g., P and/or the structure related thereto) for discharging the stacked sheets; and

means (e.g., C) for transferring the stacked sheets to at least one of said turning means, said inverting means, and said discharge means.

Monsees lacks "means for turning the stacked sheets in a plane thereof."

However, the Examiner's position is that such turning devices are old and well known in the art and provide various well known benefits including providing a desired orientation of the stacked sheets for one or more subsequent operations; for example, to provide a

specific orientation so that markings on the workpiece such as instructions, logos, etc. are oriented properly for shipping/packaging. Fujishiro is provided to show one example of such a turning means. Therefore, it would have been obvious to one having ordinary skill in the art to provide a means for turning the stacked sheets for the well known benefits including those described above. It is noted that, during prosecution, the Examiner took Official notice regarding the use of such turning units, and that other examples of such turning units could have been applied.

Regarding claim 4, the recitations set forth therein are directed solely to the type of workpiece being processed. However, the workpiece is not being claimed, and there is no suggestion as to how the specifics of the workpiece define or imply any structure of the claimed apparatus. Therefore, the specific type of material being processed (that is, films produced in the manner described) must be given little or no patentable weight.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Monsees, pn 5,743,374, in view of Fujishiro et al., pn 3,595,370, as applied to claim 1 above, and further in view of Japanese Publication 1-210298 (hereafter JP '298).

The combination lacks a cutting unit disposed between the supply means and the turning means, for cutting off corners of said sheets. However, the Examiner's position is that cutting units provided in sheet manufacturing lines are old and well known in the art for various well known benefits including providing cuts and/or cut-out portions in the sheet material for a desired sheet configuration. JP '298 provides one example of such

a cutting unit. Therefore, it would have been obvious to one having ordinary skill in the art to provide a cutting unit on the apparatus of Monsees for the well known benefits including those described above. It is noted that, during prosecution, the Examiner took Official notice regarding the use of such cutting units, and that other examples of such cutting units could have been applied.

(11) Response to Argument

As clearly stated in the prior art rejection above, the Examiner's position is that the prior art of record teaches or at least suggests the claimed combination of features. Appellant has provided several arguments against the Examiner's rejection. However, it is respectfully submitted that the arguments made by appellant cannot be considered to be persuasive for the following reasons.

A. "Whether, under 35 USC 103(a), one would have been motivated to combine the teachings of Monsees in view of Fujishiro"

In the first paragraph on page 7 of the Appeal Brief, Appellant states that

"Monsees also does not disclose a need to have a means for turning."

While the Examiner acknowledges that this statement is true, it cannot be considered to be persuasive regarding the patentability of the present invention over the prior art. In general, applicants are instructed to only disclose that which is necessary to teach one having ordinary skill in the art how to make and/or use the invention. It is not necessary, and may even be considered undesirable, that they disclose all possible

uses or potential modifications of their invention. Therefore, simply because the invention disclosed by Monsees does not explicitly describe a "means for turning," this does not suggest that such a modification has not been contemplated, is not known, or would not be obvious.

**I. ONE WOULD NOT HAVE BEEN MOTIVATED TO COMBINE THE
TEACHINGS OF MONEES AND FUJISHIRO SO AS TO DERIVE THE CLAIMED
FEATURES**

In the second paragraph on page 8 of the Appeal Brief, appellant argues that "the Examiner has not provided, nor do the references provide, any teaching or suggestion that would have motivated one skilled in the art to randomly combine the turntable 10 of Fujishiro with Monsees."

While the Examiner may agree that the prior art does not teach one skilled in the art to "randomly combine" the turntable of Fujishiro with Monsees, the Examiner respectfully submits that the prior art of record teaches or at least suggests to one having ordinary skill in the art the addition of a turning means (such as, but not limited to, the turntable of Fujishiro) to a sheet stack processing line such as that of Monsees. While it is acknowledged that Monsees does not explicitly teach or suggest such a combination, the Examiner's position is that, given the prior art taken as a whole combined with the level of skill and knowledge of one having ordinary skill in the art, it would have been obvious to one having ordinary skill in the art to provide an additional device for properly orienting the workpiece in the manufacturing/processing line. It is emphasized that contrary to appellant's argument, the Examiner has not suggested that the turning

means be “randomly combined” with Monsees. Rather, the Examiner’s position is that it would have been obvious to one having ordinary skill in the art to provide a turning means for the benefits described in the rejection; that is, to provide a means for turning the stacked sheets for the well known benefits including providing a desired orientation of the stacked sheets for one or more subsequent operations; for example, to provide a specific orientation so that markings on the workpiece such as instructions, logos, etc. are oriented properly for shipping/packaging. Anyone who has used cartons is well aware of the print commonly found on cartons, wherein the print has a wide variety of purposes including advertising (e.g., logos, tradenames) and/or instructions for use and/or delivery (e.g., “this end up”). While the invention of Monsees is not concerned with such orientation considerations, it is clear that such considerations must be recognized in various situations when processing such stacks of cartons, for example, for shipping or storing. Other reasons for turning stacks of cardboard that are well known to those of ordinary skill in the art including aligning and/or offsetting fold lines in the cardboard sheets to facilitate proper orientation for shipping/packaging.

In the second paragraph on page 10 of the Appeal Brief, appellant argues that “[T]he Examiner is essentially adding disclosure to Monsees.” The Examiner respectfully disagrees with appellant’s statement. As appellant is well aware, patents are not intended to be a fully comprehensive resource of what is known to one having ordinary skill in the art regarding a particular invention. Rather, patents are intended to provide sufficient information to enable one having ordinary skill in the art to make and/or use the invention being claimed in that patent. Thus, the question is not whether

Monsees alone teaches or suggests the claimed invention. Rather, the question is whether the prior art, taken as a whole, teaches or suggests the claimed invention. The Examiner respectfully submits that Monsees in view of the prior art, taken as a whole, particularly in combination with the prior art of record, teaches or suggests the claimed invention.

As previously stated, Fujishiro has been provided as merely one example of such a turning means. It is respectfully submitted that Fujishiro sufficiently teaches one having ordinary skill in the art the structure as well as the benefits of providing a turning means in a sheet stack manufacturing/processing line. However, it is emphasized that many other examples exist.

II. THE EXAMINER HAS IMPROPERLY PICKED AND CHOSEN ELEMENTS

In the second paragraph on page 11 of the Appeal Brief, appellant argues that the Examiner "has done nothing more than establish that a turning mechanism is a known apparatus." Appellant then argues that "the Examiner has provided absolutely no evidence that would have led a person of ordinary skill in the art to specifically select the turning mechanism of Fujishiro and insert it into Monsees." Finally, in the third paragraph on page 11 of the Appeal Brief, appellant states that the Examiner is "clearly employing impermissible hindsight in arriving at the claimed invention." The Examiner respectfully disagrees with appellant's position. In the rejection, the Examiner has clearly provided a number of reasons that one having ordinary skill in the art would be motivated to provide a turning means on the apparatus of Monsees. Fujishiro is merely but one example of such a turning means. The art of material handling, including the

handling of stacks of carton blanks, is exceedingly old, and there is a large number of ways and reasons to manipulate such material in a processing line. A turning means which merely rotates material, including a stack of carton blanks, by 180 degrees is well known and the Examiner maintains the position that the simple insertion of such a turning means is not sufficient to distinguish the claimed invention over the prior art.

B. "Whether the combination of Monsees and Fujishiro would have taught or suggested each claimed feature"

I. THE COMBINATION OF MONSEES AND FUJISHIRO FAILS TO TEACH OR SUGGEST EACH CLAIMED FEATURE

On pages 11-13 of the Appeal Brief, appellant argues that the structure disclosed by Monsees does not meet the structure of the claimed invention as each limitation thereof invokes 35 USC 112, 6th paragraph and must be interpreted as such. The Examiner respectfully disagrees with appellant's position for the following reasons. When encountering a limitation under 35 USC 112, 6th paragraph, the Examiner must apply a 3-prong test regarding the applied prior art. First, does the prior art element perform the function specified in the claim? With regard to the applied prior art including Monsees, the Examiner has established that the respective prior art elements perform the corresponding function specified in the claims. Second, does any explicit definition provided in the specification exclude the prior art elements as an equivalent? The Examiner respectfully submits that no such definition is believed to be provided in the specification and appellant has made no arguments regarding any such definitions. Third, is the prior art element an equivalent of the means-plus function limitation? The

Examiner respectfully submits that the prior art elements are equivalents to the corresponding means-plus function limitations. More specifically, each prior art element performs the identical function in substantially the same way and produces substantially the same result. Further, the prior art elements are considered to be interchangeable, have insubstantial differences and are structural equivalents with respect to the corresponding structure defined by the means-plus function limitations. Thus, it is respectfully submitted that the prior art meets the means-plus function limitations of the claimed invention.

II. THE FEATURES OF CLAIM 4 ARE NOT TAUGHT OR SUGGESTED BY MONSEES OR FUJISHIRO

In the second paragraph on page 15 of the Appeal Brief, appellant argues that "the apparatus of Monsees is not capable of transferring films produced by cutting a rolled photosensitive medium." Appellant adds that "a photosensitive medium has a different size and must be handled in a more delicate fashion" as compared to carton blanks. Finally, in the paragraph bridging pages 15-16 of the Appeal Brief, appellant states that "the features of sheets the comprise films ... impart a structural limitation to the claimed invention that cannot be ignored by the Examiner." The Examiner respectfully disagrees with appellant's position. Most notably, appellant refers to the imparting of "a structural limitation to the claimed invention." However, appellant has not specifically identified this structural limitation; that is, it is not at all clear as to what structure is being implied or otherwise defined by the recitation of the work piece. The Examiner respectfully submits that the recitation of the specific work piece (i.e., film) in

the present claims does not infer any structural limitation(s) and thus cannot serve to distinguish the claimed invention over the prior art.

III DEPENDENT CLAIMS 2 AND 3

Regarding claim 2, the Examiner respectfully disagrees with appellant's position and maintains that the prior art suggests the invention as set forth in claim 2.

Regarding claim 3, this claim has been withdrawn from consideration and is not at issue in this appeal brief. Rejoinder of claim 3 will be considered upon the determination of allowable subject matter.

For at least the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



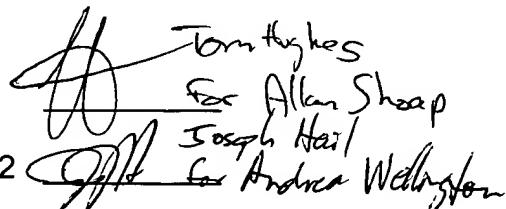
Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
July 11, 2005

Conferees:

Allan Shoap, SPE, Art Unit 3724

Andrea Wellington, SPE, Art Unit 3722



Tom Hayes
for Allan Shoap
Joseph Hail
for Andrea Wellington

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213